

USSN: 09/666,928
Atty. Docket No.: 10188/2
Amdt. dated May 21, 2004
Reply to Adv. Action of April 2, 2004
and Final OA of January 21, 2004

REMARKS/ARGUMENTS

Applicants have amended claims 13-15 and 17-18 so that they now require a core layer "consisting essentially of" polypropylene homopolymer. Claim 19 has been cancelled and rewritten in independent form as "new" claim 21. Claim 21 requires a heat-sealable multilayer white opaque plastic film comprising a core layer consisting essentially of polypropylene homopolymer, a phosphite antioxidant, a fluoropolymer anti-condensing agent and a polybutylene terephthalate cavitating agent. None of the additives in the core layer modify the tacticity of the polypropylene homopolymer so that it maintains a high stereo-regularity.

Independent claims 13 and 17 of the present application require a cavitated core layer that "consists essentially of" a propylene homopolymer of high stereo-regularity and a cavitating agent consisting essentially of polybutylene terephthalate. Support for the structure of the core layer is found in the specification which discloses that the film, "includes a cavitated polypropylene core layer," wherein, "[t]he cavitating agent incorporated into the polypropylene core layer is a polybutylene terephthalate polymer." Spec., p. 2, lines 3-4 and 14-15. The transition phrase "consisting essentially of" is properly used since the specification discloses that the cavitated core layer is a polypropylene cavitated with a polybutylene terephthalate polymer and may contain additives and agents. At page 4, line 27 - page 5, line 2, the specification states:

Other additives and agents may be suitable for incorporation into one or more layers of the films of the present invention. Additives may be selected from any class of additives, including for example, antioxidants, anti-condensing agents, slip agents, pigments, fillers, foaming agents, flame retardants, photodegradable agents, UV sensitizers or UV blocking agents, crosslinking agents, silicon compounds (e.g. SiO₂) and anti-block agents to name but a few of the many known additives.

The additives disclosed in the specification are selected to improve processing of the films or to impart characteristics to the films (such as color) that do not substantially change the film. Section 2111.03 of the MPEP, citing *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976), states that, "The transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and

USSN: 09/666,928
Atty. Docket No.: 10188/2
Amdt. dated May 21, 2004
Reply to Adv. Action of April 2, 2004
and Final OA of January 21, 2004

novel characteristic(s)' of the claimed invention." (Emphasis in original.) The core layer of the films in claims 13 and 17 require a cavitated propylene homopolymer of high stereo-regularity. The additives and/or agents that may be added to the core layer do not materially affect the basic and novel characteristics of the claimed invention.

The Court of Appeals for the Federal Circuit has recognized that the use of the transition phrase "consisting essentially of" limits the claim to the essential ingredients or steps in a claim. In *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 [48 USPQ2d 1351] (Fed. Cir. 1998), the Court stated:

"Consisting essentially of" is a transition phrase commonly used to signal a partially open claim in a patent. Typically, "consisting essentially of" precedes a list of ingredients in a composition claim or a series of steps in a process claim. By using the term "consisting essentially of," the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.

The specification clearly discloses that additives and agents, which do not change the basic nature of the films, may be added. Accordingly, it is proper to use the transition phrase "consisting essentially of" in the claims.

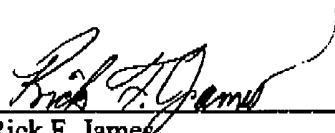
Similarly, new claim 21 uses the transition phrase "consisting essentially of" in describing a core layer consisting essentially of a polypropylene homopolymer of high stereo-regularity, a fluoropolymer anti-condensing agent and a cavitating agent consisting essentially of polybutylene terephthalate. For the same reasons stated above, the use of the transition phrase "consisting essentially of" is proper in claim 21.

USSN: 09/666,928
Atty. Docket No.: 10188/2
Amdt. dated May 21, 2004
Reply to Adv. Action of April 2, 2004
and Final OA of January 21, 2004

Applicants respectfully submit that the amendments to the claims made herein, have placed the application in condition for allowance. The Applicants, therefore, respectfully request that the rejections of the claims be withdrawn. If resolution of any remaining issue is required prior to allowance of the application, it is respectfully requested that the Examiner contact Applicants' undersigned attorney at the telephone number provided below.

Respectfully submitted,

Date: May 21, 2004



Rick F. James
Registration No. 48,772

Post Office Address (to which correspondence is to be sent)
ExxonMobil Chemical Company
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Telephone No. (281) 834-2438
Facsimile No. (281) 834-2495